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PATENT
Attorney Docket No. 053946/338424
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Michelle GRANDY)	Group Art Unit: 3632
Application No.: 10/792,107)	Examiner: Tan Le
Filed: March 3, 2004)	
For: DECORATIVE HANGING)	
WASTEBASKET)	

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450**APPEAL BRIEF****I. REAL PARTY IN INTEREST.**

The real party in interest is Michelle Grandy.

II. RELATED APPEALS AND INTERFERENCES.

There are no prior and/or pending appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee that may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS.

Although the claims in this application have remained unchanged since July 5, 2005, the Examiner has issued several election and restriction requirements at various times (even after substantive office actions) throughout the prosecution of this application. This practice of continually changing the line has been not fair to Applicant.

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See, e.g., MPEP 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.") Also, as discussed below, the Examiner on his own initiative reopened prosecution after Applicant filed a first appeal brief on a rejection only to issue the same rejection again in a subsequent office action denying Applicant the opportunity to have rejection considered by the Board after much time and expense of preparing a first Appeal Brief.

When claims 1-31 were pending in the application, the Examiner asserted that Applicant's claims were directed to two distinct inventions. Specifically, the Examiner asserted that claims 1-12, 15-22, and 27-31 ("Invention I") were directed to an apparatus and that claims 13-14 and 23-26 ("Invention II") were directed to "a method of use". (See January 5, 2005 Office Action.) The Examiner further asserted that the application contained claims directed to patentably distinct species and identifies the following alleged species: Figs. 1-2; Figs. 3-6; Fig. 7; and Fig. 9. (*Id.*) In response to the first restriction and election requirements, Applicant provisionally elected to prosecute Invention I, with traverse, and elected the species of Figs. 1-2, with traverse, on which Applicant asserted that claims 1-8, 12-16, and 19-31 read. (See Second Response to Restriction and Election Requirement dated February 6, 2006.) The Examiner concluded that claims 7-8, 10, 13, 14, 17-18, and 23-26 are drawn to a nonelected species/group and withdrew these claims from further consideration, which Applicant respectfully disputes. (See May 5, 2006 Office Action.) Thereafter, claims 1-6, 9, 11, 12, 15, 16, 19-22, and 27-31 were pending and stood rejected, which Applicant previously appealed. (See March 9, 2007 Amended Appeal Brief).

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Now, after three (3) years since the first office action issued in this matter and several office actions on the merit, the Examiner asserts that Applicant's claims are directed to *three* distinct inventions. (See May 1, 2008 Office Action). Specifically, the Examiner now asserts that claims 1-10, 12, 15-22, and 27-31 ("New Invention I") are directed to an apparatus for securing and concealing a storage unit; claim 11 ("New Invention II") is directed to an apparatus; and claims 13-14 and 23-26 ("New Invention III") are directed to a method of use. The Examiner further asserts that the application contains claims directed to patentably distinct species and requires Applicant to elect a species. The Examiner now identifies the following alleged species: Fig. 2; Fig. 3; Fig. 7; and Fig. 8. In response to the latest restriction and election requirements, Applicant provisionally elected to prosecute New Invention I and elected the species of Fig. 1 on which claims 1-6, 12-16, and 19-31 read.

The Examiner has indicated that claims 1-21 are pending, however, claims 7-11, 13, 14, 17, 18, and 23-26 are withdrawn from consideration due to Applicant's election. The Examiner asserts that claims 1-6, 12, 15-16, 19-22, and 27-31 read on the elected species and has only considered these claims in the outstanding final office action. Accordingly, claims 1-6, 12, 15-16, 19-22, and 27-31 are pending and stand rejected. Applicant appeals the rejection of claims 1-6, 12, 15-16, 19-22, and 27-31.

In the Final Office Action dated April 15, 2009, the Examiner has finally rejected claims 1-6, 12, 15-16, 19-22, and 27-31 under 35 U.S.C. § 102(b) as being anticipated by both Har (U.S. Patent 5,377,941) and Larkin (U.S. Patent 5,020,751) for the same reasons that these claims were rejected in the office actions dated July 17, 2007 and October 3, 2008. Applicant completely responded to these rejections in responses

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dated December 17, 2007 and December 31, 2008, in which Applicant raised numerous arguments traversing the Examiner's § 102 rejections. Instead of responding to all the material traversed in Applicant's response, the Examiner merely produced essentially carbon copy office actions thereby further delaying the prosecuting of this application, an application that has been pending since March 3, 2004. This practice is not fair to Applicant.

IV. STATUS OF AMENDMENTS.

No amendments have been filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER.

Applicant provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal with exemplary reference to the specification, and to the drawing, if any, by reference characters. Claims 1, 11, 12, 27, and 29 are independent claims.

Claim 1 recites an apparatus (100) for securing and concealing a storage unit (130) comprising a holder (110, 210, 220, 230) for securing a storage unit (130) to a surface; and a cover (120) attached to the holder (110), wherein the cover (120) is sized and positioned on the holder (110) to conceal in whole or in part the storage unit (130) from being viewed in a first direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶ 15 through 6, ¶ 21.)

Claim 11 recites an apparatus comprising a storage unit (130) having a first and a second mounting piece (not shown), wherein the first mounting piece connects to a surface; and a cover (120), wherein the second mounting piece connects to the cover (120). (See, e.g., Figs. 1, Specification at p. 7, ¶ 25.)

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Claim 12 recites an apparatus comprising means for securing a storage unit to a surface (110 or 210-230 or 210, 220, 230' or 710-730); and means for concealing (120, 740) in whole or in part means for securing. (See, e.g., Figs. 1-8, Specification at p. 4, ¶¶ 16 through page 8, ¶¶ 26.). The "means for securing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least any of the following groups of elements: 110 or 210-230 or 210, 220, and 230', or 710-730. The "means for concealing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least elements 120 and/or 740.

Claim 27 recites an apparatus for providing a decorative hanging wastebasket (130), comprising a holder (110, 210, 220, 230) structured to be secured to a surface and structured to hold a container (130) into which matter can be deposited or removed and a cover (120) connected to the holder (110, 210, 220, 230) that is structured and positioned on the holder to conceal a container (130) held by the holder (110, 210, 220, 230) from being viewed in at least one direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶¶ 15 through 6, ¶¶ 21.)

Claim 29 recites an apparatus for providing a decorative hanging wastebasket (130), comprising a holder (110, 210, 220, 230) that includes a first section (210) structured to attach to a wall, a second section (220) structured to support a wastebasket above a floor adjacent to the wall, and a third section (230) structured to connect to a concealing cover; and a cover (120) connected to the third section (230) of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket (130) supported by the holder (110, 210,

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220, 230) and wherein the cover (120) is connected to the third section (230) of the holder in an orientation that hides the at least one surface of the wastebasket (130) from being seen from at least one direction. (See, e.g., Figs. 1-2, Specification at p. 4, ¶ 15 through 6, ¶ 21.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.

Applicant presents the following grounds of rejection for review.

A. Ground 1:

It appears that the Examiner continues to reject claim 2 under 35 U.S.C § 112, second paragraph, because "in claim 2[] . . . the surface . . . still indicates positively recited."

B. Ground 2:

The Examiner has rejected claims 1-6, 12, 15-16, 19-22 and 27-31 under 35 U.S.C § 102(b) as being anticipated by Har (U.S. Patent 5,377,941).

C. Ground 3:

The Examiner has rejected claims 1-6, 12, 15-16, 19-22 and 27-31 under 35 U.S.C § 102(b) as being anticipated by Larkin (U.S. Patent 5,020,751).

VII. ARGUMENT

A. Ground 1:

It appears that in the Final Office action dated April 15, 2009, the Examiner continues to reject claim 2 under 35 U.S.C § 112, second paragraph, because "in claim 2[] . . . the surface . . . still indicates positively recited." Previously, in the Office Action dated **Error! Reference source not found.** at 5-6, the Examiner rejected claims 2-6 and 16 under 35 U.S.C § 112, second paragraph, because "[c]laim 2 recites 'a plate that

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attaches to the surface' and it is unclear if the surface intended to be part of the claims or if the claims are intending to be merely claim the surface. Clarification is required."

Applicant addressed this rejection many times in the past including (1) in response to the first office action over three (3) years ago; (2) in its appeal brief; and (3) in a subsequent response after the Examiner on his own initiative re-opened prosecution in view of Applicant's appeal brief. (See Amendment dated July 5, 2005 at 19-21; Applicant's Amended Appeal Brief dated March 9, 2007 at 8-10; Response dated December 17, 2007 at 2-6; Response dated December 31, 2008 at 6-10.) For example, in Applicant's Amended Appeal Brief dated March 9, 2007 at 8-10, Applicant has stated:

It is clear that claim[] 2 . . . recite[s] . . . "surface" functionally. Claim 2, which depends on claim 1, recites, "a plate that attaches to *the surface*" . . . , referring back to the surface . . . recited in claim 1. In claim[] 2 . . . , with respect to the surface . . . , the plate and ring piece are defined in terms of attributes they possess and in terms of their functional interrelationship with the surface . . . when the plate and ring piece are used in its intended manner, rather than positively reciting the surface See, e.g., Ex parte Miller, No. 97-0972 (Bd. Pat. App. & Inter. 1998) (unpublished). In Ex parte Miller, the Examiner rejected a claim under 35 U.S.C. § 112, second paragraph, because the preamble recited "a theater seat hold-down device for maintaining a seat member" but the body of the claim recited "an elongated member . . . configured to engage at least one said seat member." The Examiner argued that "seat member" was functionally recited in the preamble but positively recited in the body and therefore presented an inconsistency thereby justifying a rejection under 35 U.S.C. § 112, second paragraph. The Board reversed the Examiner's rejection, holding:

We do not agree with the examiner's position. The examiner apparently recognizes that the appellants, by setting forth functional recitations such as that of the hold-down device being "adapted" to engage the theater seat, have not positively recited the theater seat as a part of the claimed combination.

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Nevertheless, the examiner has taken the position that limitations such as that of the of hold-down device being "configured" (i.e, shaped) to engage a portion of a theater seat (previously set forth in the preamble), positively claim the theater seat as part of the claimed combination. **We must point out, however, that by reciting such language the appellants have merely defined the hold-down member in terms of attributes it must possess and, therefore, this language is also functional in character. That is, the appellants are merely defining the shape or structural configuration of the hold-down device in terms of its functional interrelationship with the theater seat when it is used in its intended manner, rather than positively reciting the theater seat as a part of the claimed combination.** Since we are not of the opinion that the theater seat has been positively set forth as a part of the claimed combination, we find no inconsistency between the preamble and the body of the claim as the examiner asserts. This being the case, we will not sustain the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph.

(emphasis added). The Examiner provides no support for why the claims are indefinite based on what the Examiner has pointed to as the alleged problem.

In view of the Appeal Brief, in the office action dated July 17, 2007, the Examiner reopened prosecution and withdrew the rejection of claim 2 under 35 U.S.C. § 112, second paragraph and merely objected to claim 2. In a response to the objection, Applicant argued in a response dated December 17, 2007 at 2-5:

Prior to Applicant's Appeal Brief, the Examiner rejected claims 2, 9, 19, 21, 29, and 31 under 35 U.S.C. § 112, second paragraph, for the exact same reasons that the Examiner now objects to these claims. However, now, the Examiner continues to maintain the same arguments with respect to the language of claims 2, 9, 19, 21, 29, and 31 after the Examiner elected to reopen prosecution of the application instead of responding to Applicant's arguments when the issue was ready for review by the Board. However, now the Examiner has withdrawn the rejection

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under 35 U.S.C. § 112, second paragraph and only "objects" to the claims for the same reason. By withdrawing the rejection under 35 U.S.C. § 112, second paragraph, the Examiner admits that the claim language satisfies the statutory requirements of 35 U.S.C. § 112, second paragraph. Accordingly, pursuant MPEP 2173.02, Applicant respectfully requests that the Examiner provide suggested language since Applicant disagrees with the Examiner *unsupported* assessment of these claims, particularly in view of Ex parte Miller, as explained in Applicant's Appeal Brief, which is incorporated by reference.

MPEP 2173.02 provides:

[I]f the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

Applicant can see no difference between the manner in which "the surface" and "storage unit" is recited in the present claims and the manner in which "theater seat" was recited *with approval* in Ex parte Miller. . . .

In claims 2, 19, 21, and 29, the plate, ring piece, and cover are defined in terms of attributes they possess and in terms of their functional interrelationship with the surface, storage unit, and wastebasket when the plate, ring piece, and cover are used in their intended manner, rather than positively reciting the surface, storage unit, and wastebasket.

Accordingly, if the Examiner continues to maintain this objection, Applicant respectfully requests that the Examiner suggest language to his satisfaction for these claims.

After the Examiner withdrew the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, and merely objected to claim 2 in the office action dated July 17, 2007, the Examiner in the Office Action dated **Error! Reference source not found.**, again rejected claim 2 under 35 U.S.C. § 112, second paragraph. This practice of

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continually changing the line is not fair to Applicant. See, e.g., MPEP 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.")

Furthermore, the Examiner admitted in the office action dated July 17, 2007 at paragraph 4, that the surface is "not apart of the claimed invention."

In view of Applicant's numerous clarifications including Federal Circuit authority in support of Applicant's position and the Examiner's own admission, Applicant does not understand why further clarification is needed and why the Examiner continues to reject or object to claim 2 without any support from federal case law, the MPEP, the CFR, or any other authority. Applicant respectfully submits that claim 2 satisfy 35 U.S.C. § 112, second paragraph, which the Examiner previously admitted by previously withdrawing this rejection from this claims.

B. Ground 2:

1. Claims 1

Har does not disclose "a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit" as recited in claim 1. The Examiner contends that element 32 of Har is the cover recited in claim 1.

First, element 32 is a top lid and not a cover as contemplated by the specification and recited in claim 1. Second, element 32 is not "sized to conceal" a "storage unit" as recited in claim 1. The Examiner points to element 27 as the "storage unit"; however, Har discloses that element 27 is a "large central opening." Col. 3, ll. 40-41.

MPEP 2111 provides:

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During patent examination, the pending claims must be given broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

...

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe restore hair growth to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.).

See also MPEP 2111.01; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 USPQ at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original).

To interpret "cover" and "conceal" to include a top lid that does not conceal a storage unit is not reasonable, not consistent with the specification, and not consistent with the interpretation one of ordinary skill in the art would reach. Figs. 1-8 of Applicant's specification clearly illustrate a cover that conceals a storage unit; it is not a lid. A lid is on top of a storage unit and intended to close the top opening of a storage unit and not intended to conceal the storage unit in any manner. As disclosed in the Specification, "[004] . . . [T]here is a need in the art for such a new wastebasket to be

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able to accept the attachment of a decorative cover, which may, for example, match the décor of a child's room or other environment. . . . [021] . . . [The] decorative cover 120 may be a size that covers both the basket holder 110 and the wastebasket 130. The decorative cover 120 may be any shape such as a circle, square, oval, bevel, cub, can, box, square, plaque, diamond, rectangle, rounded rectangle, trapezoid, octagon, hexagon, pentagon, heart, or any other shape. The decorative cover 120 may be in various colors including blues, reds, yellows, white, purple, green, pastel colors, or any other color and may be used to complement a juvenile environment or any other environment. The decorative cover 120 may have any theme in any form, such as sports, bear, flower, butterfly, fish, smiley face, star, ballerina, heart, car, cheerleader, train or alphabets. The decorative cover 120 may be made of any material such as plastic, aluminum, steel, wood, or any combination of the foregoing."

Furthermore, a lid does not conceal as that term is commonly understood. *See, e.g., The American Heritage Dictionary of the English Language* (defining conceal as "To keep from being seen, found, observed, or discovered; hide."); *Merriam-Webster's Online Dictionary*, 11th Edition (defining conceal as "1: to prevent disclosure or recognition of <conceal the truth> 2 : to place out of sight <concealed himself behind the door>"); *Webster's New World College Dictionary*, 4th Ed. (defining conceal as "to put out of sight; hide").)

Furthermore, to interpret "storage unit" to include "a large central opening", which is the exact opposite of a "storage unit", is not reasonable, not consistent with the specification, and not consistent with the interpretation one of ordinary skill in the art would reach.

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Applicant will assume that the Examiner intended to cite to element 30 (i.e. a waste or garbage bag) as "storage unit". Har discloses:

The sink waste bag support device of this invention is generally indicated by the reference numeral 20 in FIG. 1. It is comprised of a support base 22 supported on a corner rim of sink 24. A support frame having a large central opening 27, is hingedly mounted upon the support base to **receive folded over top edges 28 of a waste or garbage bag 30** shown in dotted line over the top of the sink and support base and under the support frame in clamping relation. A hinged lid 32, generally congruent with the support frame is employed to cover the support frame and bag.

Col. 3, ll. 37-47.

As shown in Fig. 1 and disclosed in the specification of Har, element 30 (i.e., the allege storage unit) is provided on the outside of support frame 26, and when the lid 32 is closed, even from a top view, it does not conceal element 30. As shown in Fig. 1, element 30 can extend beyond the outside border of support frame 26 and element 32. Furthermore, because element 30 is not otherwise secured to prevent movement beyond the outside border, Har simply does not disclose or suggest concealing element 30. Nevertheless, element 32 is not sized to conceal in whole or in part element 30 as the terms "cover" and "conceal" are interpreted by one of ordinary skill in the art. For at least these reasons, claim 1 is patentable over Har.

2. Claim 19

Claim 19, which depends from claim 1, recites that "the cover is sized and positioned on the holder to conceal **in whole** the storage unit **from being viewed in a first direction.**" Har does not teach or suggest that the alleged cover (element 32) conceals **in whole** the storage unit when viewed from a first direction. The Examiner contends that "the direction above the cover is a first direction." (See Final Office Action

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dated April 15, 2009 at 2). However, Fig. 1 of Har shows that element 30 can extend beyond the lid 32 and can be seen from a top view. Furthermore, Har does not teach or suggest that lid 32 conceals element 30 for any direction. Thus, Har does not disclose that the lid 32 conceals **in whole** element 30. For these additional reasons, claim 19 is patentable over Har. Applicant incorporates the arguments in section VII(B)(1).

3. Claim 20

Claim 20, which depends from claims 19, recites that the first direction is directed toward a **front elevation**. Har does not teach or suggest that the alleged cover (element 32) conceals **in whole** the storage unit when viewed from a direction directed toward a **front elevation**. One of ordinary skill in the art understands that a "front elevation" is a view from the front and not a view from the top. See, e.g., U.S. Department of Commerce Patent and Trademark Office, A Guide To Filing A Design Patent Application at <http://www.uspto.gov/web/offices/pac/design/index.html>, retrieved on December 17, 2007 ("The Figure Descriptions indicate what each view of the drawings represents, i.e., front elevation, top plan, perspective view, etc."); The American Heritage Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000 (defining elevation as "A scale drawing of the side, front, or rear of a structure.").

Fig. 1 shows that element 30 can be completely seen from a front elevation. Har does not disclose that the lid 32 conceals **in whole** element 30 **when viewed from a front elevation**. For these additional reasons, claim 20 is patentable over Har. Applicant incorporates the arguments in section VII(B)(1) and (2).

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4. **Claim 21**

Claim 21, which depends from claims 1 and 19, recites, "the cover is sized and positioned on the holder to conceal **in whole the storage unit *and holder*** from being viewed in a first direction." Har does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction. The Examiner indicates that the holder comprises elements 26, 22, and 50. However, the lid 32 does not conceal in whole the alleged storage unit (element 30) and holder (elements 26, 22, and 50) when viewed from a first direction. For these additional reasons, claim 21 is patentable over Har. Applicant incorporates the arguments in section VII(B)(1) and (2).

5. **Claim 22**

Claim 22, which depends from claim 21, recites that the first direction is directed toward a **front elevation**. Har does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a direction directed toward a front elevation. The Examiner indicates that the holder comprises elements 26, 22, and 50. However, the alleged cover (element 32) does not conceal in whole the alleged storage unit (element 30) and holder (elements 26, 22, and 50) when viewed from a direction directed toward a front elevation. For these additional reasons, claim 22 is patentable over Har. Applicant incorporates the arguments in section VII(B)(1), (2), and (4).

6. **Claim 27**

Claim 27 recites, "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least

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one direction." The Examiner simply asserts that claim 27 "[is] similar to those recited in claim[] 1" Applicant incorporates by reference the arguments in sections VII(B)(1) and (2).

7. Claim 28

Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. Applicant incorporates by reference the arguments in sections VII(B)(1) and (3).

8. Claim 29

Claim 29 recites, "a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction."

Har does not teach or suggest that the alleged cover (element 32) includes "at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket." The Examiner does not particularly point out the "at least one surface" of element 30 (or the "at least one surface" of element 27, which is "a large central opening" and, therefore, does not have a surface) that at least one surface of element 32 is allegedly equivalent to or greater than.

Also, for the reason discussed in section VII(B)(2), which are incorporated by reference, Har does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction."

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9. **Claim 30**

Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. For the reason discussed in section VII(B)(3), which are incorporated by reference, Har does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from [a front elevation]."

10. **Claim 12**

Claim 12 recites an apparatus comprising means for securing a storage unit to a surface; and means for concealing in whole or in part means for securing. The "means for securing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least any of the following groups of elements: 110 or 210-230 or 210, 220, and 230', or 710-730.

The "means for concealing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least elements 120 and/or 740.

The Examiner contends that the means for securing in Har are elements 50 and 52 and that the means for concealing is element 32. However, these elements in Har are different than and are not equivalent to the corresponding structure for first means for securing and second means for concealing as set forth above.

C. **Ground 3**

1. **Claim 1**

Larkin does not disclose "a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit." The Examiner contends that element 32 of Larkin is the cover recited in claim 1.

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First, for the reason set forth in section VII(B)(1), which are incorporated by reference, element 32 is a top lid and not a cover as contemplated by the specification and recited in claim 1. Second, element 32 is not "sized to conceal" a storage unit, which the Examiner points to as element 50. More specifically, Larkin discloses:

In FIG. 1, the garbage bag 50 is retained on the outside of the ring 12 by a cord 16, preferably made of an elastic material. While the garbage bag 50 has been shown on the outside of the ring 12, greater strength may be obtained by installing the garbage bag 50 on the inside of the ring and having the outer edge fall down on the outside of the ring, so that the weight of material in the garbage bag 50 pulls the upper edge of the garbage bag 50 and the cord 16 up against the lip 14 which surrounds the ring 12.

Col. 2, ll. 11-22.

Furthermore, the only disclosure in Larkin regarding the lid 32, provides:

The ring 12 is provided with a lid 32 attached to hinge 34, which may be bolted onto the arm 18 by bolts 36 passing into holes 38 of the arm 18. The lid 32 is particularly useful for situations where the garbage bag holder 10 is used indoors.

Col. 2, ll. 44-48.

As shown in Figs. 1 and 2 and disclosed in the specification of Larkin, element 50 (i.e., the allege storage unit) is provided on the outside of ring 12, and when the lid 32 is closed, even from a top view, it does not conceal element 50. As shown in Figs. 1 and 2, element 50 can extend beyond the outside border of the ring 12 and cover 32. Fig. 2 shows element 50 extending beyond the outside border; furthermore, because element 50 is not otherwise secured to prevent movement beyond the outside border, Larkin simply does not disclose or suggest concealing element 50. Nevertheless, for the reasons set forth in section VII(B)(1), which are incorporated by

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reference, element 32 is not sized to conceal in whole or in part element 50 as the terms "cover" and "conceal" are interpreted by one of ordinary skill in the art.

2. Claim 19

Claim 19, which depends from claim 1, recites that "the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a first direction." Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole the storage unit when viewed from a first direction. The Examiner contends that "the direction above the cover is a first direction." (See Final Office Action dated April 15, 2009 at 3). However, Figs. 1 and 2 show that element 50 can extend beyond the lid 32 and can be seen from a top view. Furthermore, Larkin does not teach or suggest that lid 32 conceals element 50 for any direction. Thus, Larkin does not disclose that the lid 32 conceals in whole element 50. Applicant incorporates the arguments in section VII(C)(1).

3. Claim 20

Claim 20, which depends from claims 19, recites that the first direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole the storage unit when viewed from a direction directed toward a front elevation. One of ordinary skill in the art understands that a "front elevation" is a view from the front and not a view from the top. See, e.g., U.S. Department of Commerce Patent and Trademark Office, A Guide To Filing A Design Patent Application at <http://www.uspto.gov/web/offices/pac/design/index.html>, retrieved on December 17, 2007 ("The Figure Descriptions indicate what each view of the drawings represents, i.e., front elevation, top plan, perspective view,

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etc."); The American Heritage Dictionary of the English Language, 4th ed. Boston: Houghton Mifflin, 2000 (defining elevation as "A scale drawing of the side, front, or rear of a structure.").

Figs. 1 and 2 show that element 50 can be completely seen from a front elevation. Larkin does not disclose that the lid 32 conceals in whole element 50 **when viewed from a front elevation**. Applicant incorporates the arguments in section VII(C)(1) and (2).

4. Claim 21

Claim 21, which depends from claims 1 and 19, recites, "the cover is sized and positioned on the holder to conceal in whole the **storage unit and holder** from being viewed in a first direction." Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction. The Examiner indicates that the holder comprises elements 14, 16, 18, and 60; however, the holder also includes elements 20, 26, and 42. See Larkin col. 2, ll. 9-60. As shown in Figs. 1 and 2, the lid 32 does conceal in whole the alleged storage unit and holder (i.e., elements 14, 16, 18, 20, 26, and 42) when viewed from a first direction. Applicant incorporates the arguments in section VII(C)(1) and (2).

5. Claim 22

Claim 22, which depends from claim 21, recites that the first direction is directed toward a **front elevation**. Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction or a direction directed toward a front elevation. The Examiner indicates that the holder comprises elements 14, 16, 18, and 60; however, the holder

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also includes elements 20, 26, and 42. See Larkin col. 2, ll. 9-60. As shown in Figs. 1 and 2, the lid 32 does not conceal in whole the alleged storage unit and holder when viewed from a direction directed toward a front elevation. Applicant incorporates the arguments in section VII(C)(1), (2), and (4).

6. Claim 27

Claim 27 recites, "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction." The Examiner simply asserts that claim 27 "[is] similar to those recited in claim[] 1" Applicant incorporates by reference the arguments in sections VII(C)(1) and (2).

7. Claim 28

Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. Applicant incorporates by reference the arguments in sections VII(C)(1) and (3).

8. Claim 29

Claim 29 recites, "a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction." Larkin does not teach or suggest that the alleged cover (element 32) includes "at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket." The Examiner does not

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particularly point out the "at least one surface" of element 50 that at least one surface of element 32 is allegedly equivalent to or greater than.

Also, for the reason discussed in section VII(C)(2), Larkin does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction."

9. Claim 30

Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. For the reason discussed in section VII(C)(3), Larkin does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from [a front elevation]."

10. Claim 4

Claim 4 recites that "wherein the cover comprises a second mounting piece connected to the first mounting piece." The Examiner identifies element 42 as the first mounting piece and element 36 as the second mounting piece. For Larkin to anticipate this claim, element 36 must be connected to element 42. As shown in Fig. 1, this is clearly not the case. To get around this missing element, the Examiner attempts to reason that element 36 is connected to element 42 via element 18; however, this is an improper construction of connected. This invention is not an electrical invention in which "connected" generally is construed broadly; but, in the mechanical context, it's unreasonable to assert that two pieces are connected when they are joined by a multitude of intervening pieces as shown in Figs. 1 and 2.

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11. Claim 16

Applicant incorporates by reference the arguments in sections VII(C)(10). Furthermore, with respect to claim 16, which recites, "a second mounting piece structured to attach to the cover and first mounting piece", Larkin does not disclose that element 36 is structured to attach to element 42.

12. Claim 12

Claim 12 recites an apparatus comprising means for securing a storage unit to a surface; and means for concealing in whole or in part means for securing. The "means for securing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least any of the following groups of elements: 110 or 210-230 or 210, 220, and 230, or 710-730. The "means for concealing" element is a means plus function element and the structure described in the specification as corresponding to the claimed function are at least elements 120 and/or 740.

The Examiner contends that the means for securing in Larkin are elements 60, 42, and 14 and that the means for concealing is element 32. However, these elements in Larkin are different than and are not equivalent to the corresponding structure for first means for securing and second means for concealing as set forth above.

VIII. CLAIMS APPENDIX.

Appendix A contains a copy of the claims involved in the appeal.

IX. EVIDENCE APPENDIX.

No evidence appendix is provided as there was no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

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X. RELATED PROCEEDINGS APPENDIX.

No related proceedings appendix is provided as there are no decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii).

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Respectfully submitted,

/Charlena Thorpe/
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APPENDIX A

1. (Previously Presented) An apparatus for securing and concealing a storage unit, comprising:

a holder for securing a storage unit to a surface; and
a cover attached to the holder, wherein the cover is sized and positioned on the holder to conceal in whole or in part the storage unit from being viewed in a first direction.

2. (Original) The apparatus of claim 1, wherein the holder comprises:

a plate that attaches to the surface;
a ring piece attached to the plate that receives the storage unit and holds the storage unit in place; and
a first mounting piece attached to the ring piece.

3. (Original) The apparatus of claim 2, wherein any combination of the plate, the ring piece, and the first mounting piece are detachable.

4. (Original) The apparatus of claim 2, wherein the cover comprises a second mounting piece connected to the first mounting piece.

5. (Original) The apparatus of claim 4, wherein the second mounting piece is detachable from the first mounting piece.

6. (Original) The apparatus of claim 4, wherein the second mounting piece is detachable from the cover.

12. (Previously Presented) An apparatus comprising:

means for securing a storage unit to a surface; and
means for concealing in whole or in part means for hanging securing.

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15. (Previously Presented) The apparatus of claim 1, wherein the first direction is directed toward a front elevation.

16. (Previously Presented) The apparatus of claim 2, further comprising a second mounting piece structured to attach to the cover and the first mounting piece.

19. (Previously Presented) The apparatus of claim 1, wherein the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a first direction.

20. (Previously Presented) The apparatus of claim 19, wherein the first direction is directed toward a front elevation.

21. (Previously Presented) The apparatus of claim 19, wherein the cover is sized and positioned on the holder to conceal in whole the storage unit and holder from being viewed in a first direction.

22. (Previously Presented) The apparatus of claim 21, wherein the first direction is directed toward a front elevation.

27. (Previously Presented) An apparatus for providing a decorative hanging wastebasket, comprising:

a holder structured to be secured to a surface and structured to hold a container into which matter can be deposited or removed; and

a cover connected to the holder that is structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction.

28. (Previously Presented) The apparatus of claim 27, wherein the at least one direction is directed toward a front elevation.

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29. (Previously Presented) An apparatus for providing a decorative hanging wastebasket, comprising:

a holder that includes a first section structured to attach to a wall, a second section structured to support a wastebasket above a floor adjacent to the wall, and a third section structured to connect to a concealing cover; and

a cover connected to the third section of the holder that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction.

30. (Previously Presented) The apparatus of claim 29, wherein the at least one direction is directed toward a front elevation.

31. (Previously Presented) The apparatus of claim 29, further comprising a wastebasket connected to the second section of the holder.